

REMARKS

Claims 1-25 are currently pending in the application, with claims 1, 11 and 21 being independent. Applicants request favorable consideration in light of the comments contained herein and earnestly seek timely allowance of the pending claims.

Request for Consideration of IDS

Applicant has not yet received an Information Disclosure Statement (IDS), filed on February 11, 2004, which has been considered by the Examiner. Applicant encloses herewith a copy of the as-filed IDS, along with the stamped postcard receipt, for the convenience of the Examiner. Applicant respectfully requests the Examiner consider the IDS and indicate such consideration with the appropriate markings on the enclosed PTO-1449.

Request for Consideration of Claims 21-25

In Applicant's reply filed on June 16, 2004, new claims 21-25 were properly submitted along with the associated excess claim fees. Because the Office Action has not indicated these claims as being rejected, Applicant assumes the Examiner considers claims 21-25 allowable. If the Examiner further wishes to prosecute these claims, it is respectfully requested that another non-Final Office Action be issued.

Allowable Subject Matter

The Examiner indicated that claims 6-8 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include

all of the features of the base and any intervening claims. Applicant wishes to thank the Examiner for the indication of allowable subject matter.

Claim Rejections – 35 USC §102

In the Office Action, claims 1-3, 9-13, and 19-20 were rejected under 35 USC 102(e) as being anticipated by US Patent No. 6,288,750 to Yamada et al. (“Yamada”). Applicant maintains the Examiner has failed to establish a *prima facie* case of anticipation and traverse this rejection.

In order to properly anticipate Applicant’s claimed invention under 35 USC 102(e), each and every element of the claim in issue must be found, either expressly described or under the principles of inherency, in a single prior art reference. Furthermore, “the identical invention must be shown in as complete detail as is contained in the...claim.” See MPEP §2131 (8th edition, May 2004), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Yamada merely discloses a receiver, which demodulates an incoming signal and separates the demodulated signal into a video stream, an audio stream, and additional information data stream, and other types of information, which are multiplexed in a time-divisional manner. (Col. 4, line 59 through col. 5, line 4; Fig. 1). Once demultiplexed from the received data stream, the additional information is denoted as Ss. This additional information Ss are control codes for video output: Copy generation control and copy guard are performed on the basis of the additional (control code) information. (Col. 5, lines 8-15).

Furthermore, Yamada’s CPU generates on-screen display (OSD) data, denoted as So, and

outputs the OSD data So and the additional information Ss to the video decoder through a data bus 11 (col. 5, lines 15-18). OSD data stands for a channel, a receiving mode, a volume, characters of text broadcasting and the like displayed on a currently operating television screen. (Col. 5, lines 18-21). The additional confirmation recognizing part 2 of 3 accepts the additional information Ss and the OSD data inputted from the data bus 11, and stores the additional information Ss in the OSD data So in the work RAM 202 (col. 5, lines 46-50).

Conversely, Yamada fails to disclose, at least, “an associated information storage means for storing associated information independent from, and interchangeable with the added information,” as recited in claim 1 (emphasis added), and “storing information independent from and interchangeable with the added information,” as recited in claim 11 (emphasis added).

The Examiner asserts that “the OSD data (So), additional information (Ss) and broadcast wave information (Sb) received from an outside source as shown in Fig. 2 and which information clearly and unambiguously would be interchangeable...” (See Office Action page 2, paragraph No. 2., lines 8-10). The Examiner further asserts that “Yamada does not does not preclude the additional information Ss, and the OSD data So stored in work RAM 202 from being interchangeable. ... Nowhere does Yamada disclose these additional information may not be interchangeable. In fact, since the OSD data can be both text or image/graphics, there is not reason such data cannot be interchangeable with the additional info such as CGMS data.” (Office Action, pages 7-8, paragraph No. 6, lines 12-17.)

Applicant submits that the Examiner’s reasoning is misguided and the fact that Yamada does not disclose the information may not be interchangeable fails to establish a *prima facie* case of anticipation for establishing a proper rejection for claims 1 and 11. It is well settled that a

rejection under 35 USC §102 is not proper based upon these facts. See, for example, Continental Can Co. USA, Inc. v. Mansanto, 20 USPQ 2d 1746, 1749, 1750 (Fed. Cir. 1991), which stated as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled...[such] that the missing...matter is necessarily inherent in the...reference, and that it would be so recognized by persons of ordinary skill...Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient...

Moreover, Applicant submits that Yamada's disclosure is inconsistent with the Examiner's assertion that the OSD data, the additional information data, are "clearly and unambiguously" interchangeable. For example, Yamada discloses that copy generation control and copy guard are performed on the basis of the additional Ss information (col. 5, lines 13-15). The OSD information includes characters of text broadcasting and the like displayed on a currently operating television screen (col. 5, lines 19-22). The types of information are sufficiently different enough that Yamada fails to disclose interchanging them. In fact, Yamada discloses a structure for combining the additional information Ss with the read video data Sv and OSD data So. Specifically, the combining part 209 combines the OSD data So and the additional information Ss with the video data Sv. (See col. 7, lines 28-30.)

Clearly, Yamada fails to anticipate claims 1 and 11 under §102, and Applicant respectfully requests the Examiner withdraw the rejection of these claims. Claims 9 and 10

depend from claim and are allowable at least for the reasons described above for allowable claim

1. Claims 19 and 20 depend from claim 11 and are allowable by virtue of their dependency at least for the reasons described above for allowable claim 11.

Claim Rejections – 35 USC §103

The Office Action indicated claims 5 and 15 are rejected under 35 USC 103(a) as being unpatentable over Yamada. Applicant submits the Examiner failed to establish a *prima facie* case of obviousness and traverse this rejection.

Claim 5 depends from allowable claim 1, and claim 15 depends from allowable claim 11, as such these claims include all of the features recited their respective base claims. As described above under rejections for claims 1 and 11, Yamada fails to disclose all of the features recited in these claims.

Accordingly, claim 5 is allowable at least for the reasons described above for claim 1; and claim 15 is allowable at least for the reasons described above for allowable claim 11. Applicant respectfully requests the Examiner to withdraw the §103 rejection of claims 5 and 15.

The Office Action indicated that claims 4 and 14 are rejected under 35 USC 103(a) as being unpatentable over Yamada in view of US Patent 5,684,514 to Branscomb (“Branscomb”). Applicant disagrees and traverses this rejection.

Applicant respectfully submits that Branscomb fails to cure the deficiencies of Yamada. Branscomb fails to teach or suggest, at least, “an associated storage means for storing associated information independent from, and interchangeable with, the added information,” as required by claim 4 and storing associated information different from, and interchangeable with, the added

information,” as required by claim 14.

Accordingly, Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of claims 4 and 14.

Conclusion


In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at telephone number (703) 205-8000, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: July 20, 2005

Respectfully submitted,

By 
Michael R. Cammarata
Registration No.: 39,491
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: Copy of PTO-1449 form dated 2/11/04
Stamped Postcard Receipt dated 2/11/04